

Redd, et al.  
Application No.: 10/627,393

The instant application is a continuation of U.S. Patent Application Serial No. 09/450,899, entitled "Backprinting Image Prints", filed 11/29/1999. Priority is claimed from U.S. Provisional Patent Applications Serial No. 60/151,533, filed on 8/31/1999, Serial No. 60/159,372, filed 10/14/1999, and Serial No. 60/167,675, filed 11/24/1999, and entitled  
5 "Digital Photo Printing Services." The instant application is assigned to Shutterfly, Inc., located in Redwood City, California.

Chui et al. (US 6,657,702) is assigned to the same assignee Shutterfly, Inc. as the instant application. The filing date of US 6,657,702 is 11/29/1999 after the priority date of the instant patent application. US 6,657,702 also claims the same priority patent applications  
10 as the instant patent applications. Per 35 U.S.C. 103(a) and 35 U.S.C. 103(c), Chui et al. is not prior art to the instant patent application.

Calhoun relates to a method of providing information on the back side of a developed photographic medium having an image carrying layer on the front side by machine reading code on the developed imaging carrying layer on the front side of the photographic medium.  
15 In the method, information is printed on the back side of the developed photographic medium with a printer, based on the machine read code. Calhoun also shows an apparatus for providing information on a back side of a developed photographic medium having an image carrying layer on the front side, has a reader to read machine readable code in the developed imaging carrying layer on the front side of the photographic medium. The apparatus further  
20 has a printer communicating with the reader so as to print information on the back side of the developed photographic medium based on the machine read code. The method may include printing and developing the photographic medium.

Yamamoto relates to film information communication apparatus having a picture reading mechanism for reading information recorded in a photosensitive emulsion layer, in a  
25 photographic film including a photosensitive emulsion layer and a magnetic recording layer, a magnetic recording and reading mechanism for reading information recorded in the magnetic recording layer, a film information reading mechanism for reading information recorded in other portion of the film than the photosensitive emulsion layer and magnetic

Redd, et al.  
Application No.: 10/627,393

recording layer, and a communication control mechanism for outputting the information for printing read out by each reading mechanism.

Chui is not prior art, and neither Calhoun nor Yamamoto shows the independent claim, namely a printing system for producing image print having customized message from a user to a recipient on the back side of the image print, comprising:

a front-end computer sub-system for receiving an image and a customized message from the user, wherein the customized message is generated by the user for a recipient in association with the image;

a scheduler in communication with the front-end computer sub-system;

a printer, in communication with the scheduler, that prints the image on the front side of a paper substrate to produce an image print; and

a backprinter that receives the image print from the printer and prints the user-generated and customized message on the back side of the image print, whereby the image print having the customized message is sent to the recipient.

Since a number of elements are missing, the references cannot render the independent claims (and those claims dependent therefrom) obvious.

In view of above argument, Claims 1-14 cannot be rejected over Chui et al. (US 6,657,702) alone or in view of Calhoun (US 6,181,409) or Yamamoto et al. (US 5,703,701). Withdrawal of the Section 103 rejections is requested.

#### OATH/DECLARATION

Applicant has responded to Mr. Douglas Wood at the Office of Petitions on 4/19/2004 regarding the Denial of Petition dated 4/2/2004 by submitting additional documentation to the previous petitions. A copy of applicant's response on 4/19/2004 is attached. Applicant believes that the additional information submitted should be sufficient for petition approval.